

Remarks/Arguments:

Claims 1-3 and 5-38 are pending in this application. Claim 29 has been canceled as being substantially identical to claim 1. The Office Action rejects claims 1-3 and 5-38 based on U.S. Patent No. 6,017,363 to Hojeibane (Hojeibane) in light of U.S. Patent No. 6,015,431 to Thornton et al. (Thornton). The applicants respectfully submit that claims 1-3, 5-28, and 30-38, as amended, recite limitations neither taught nor suggested by Hojeibane or Thornton taken individually or in combination. For the reasons set forth below, the applicants respectfully submit that claims 1-3, 5-28, and 30-39 should be allowed.

35 U.S.C. § 103(a)

Claims 1-3 and 5-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hojeibane in view of Thornton. The applicants respectfully traverse this rejection.

Hojeibane is relied upon in the Office Action for its disclosure of a bifurcated stent apparatus. Thornton is relied upon in the Office Action for its disclosure of "a bifurcated stent including stent cover and seal ring." See Office Action of June 29, 2004 at page 2.

There is no need, and hence no suggestion, for either reference to adopt or be combined with the structure disclosed in the other reference. Specifically, there is no suggestion to combine (a) features of an interlocking stent used to relieve a vascular obstruction, as disclosed by Hojeibane, with (b) an endoluminal stent-graft used to isolate a vascular aneurysm and having a leak-resistant seal in an iliac leg region of the stent-graft. Indeed, Thornton teaches, at best, modular components that seal against one another in an iliac leg region, whereas the applicants' claimed invention as recited in claims 1, 27, 30 and 31, and claims depending therefrom, comprises a sealing relationship between a first trunk portion and a second trunk portion. Therefore, the applicants respectfully submit that a person of ordinary skill in the art would not be motivated to combine the references as suggested by the Examiner, and even if such a combination were made, the combination fails to teach the applicants' invention as claimed.

Hojeibane does not disclose a sealing relationship between modular members at all, because it only discloses an uncovered stent, and Thornton does not disclose a sealing relationship between trunk portions of a multi-component device. Accordingly, the general teachings of Thornton relating to the use of a graft covering on interlocking iliac leg portions of a modular stent do not suggest providing covering on interlocking modular portions of the type

taught in Hojeibane, and specifically do not suggest providing such a covering in a way that creates a sealing relationship in the trunk region of the stent.

Claim 25 recites a modular endoluminal device comprising first and second members, in which the first member and second member are "adapted to interlock together such that [fluid flow] forces the second member against the first member in a sealing relationship." For the same reasons as discussed above, the cited references do not teach the claimed invention, as Thornton teaches stent-graft members that seal against one another only in the iliac leg region, and Hojeibane does not teach a sealing relationship at all. Thus, there is no disclosure of fluid flow forcing interlocking members together in either reference, nor would fluid flow inherently provide an impingement force in the systems disclosed by either reference. In fact, fluid flowing through the interlocking components of Thornton would inherently pull the two members apart, not force them together. The fluid flow would have essentially no impact on the uncovered stents disclosed in Hojeibane.

There must be objective motivation to support an obviousness rejection. *Ex parte Metcalf*, 67 USPQ2d 1633 (May 2, 2003). More specifically, the mere fact that teachings found in the prior art could be combined as proposed by an examiner does not make the combination obvious "absent some teaching, suggestion or incentive supporting the combination." *Id.* at 1635 (citing *Carella v. Starlight Archery and Pro Line Co.*, 231 USPQ 644, 647 (Fed. Cir. 1986)). It is respectfully submitted that the Examiner has failed to identify any such teaching, suggestion, or incentive to support his proposed combination. Accordingly, it is respectfully submitted that claims 1, 25, 30 and 31, as amended, are patentable over the art of record. Likewise, it is respectfully submitted that claims 2, 3, 5-24, and 39 which depend from claim 1, claims 26-28 which depend from claim 25, and claims 32-38 which depend from claim 31 are also patentable over the art of record.

Moreover, the applicants' invention, as recited in claim 2, includes another feature that is neither disclosed nor suggested by Hojeibane or Thornton taken individually or in combination. Claim 2 depends from claim 1 and adds the following feature:

wherein the second midsection further comprises a leg stump portion that protrudes into the first leg portion of the first member in the assembled configuration.

Neither Hojeibane nor Thornton disclose this feature. *Prima facie* obviousness therefore cannot be established based on the cited references. Thus, the applicants respectfully submit that this limitation presents an additional basis for allowing claim 2.

Similarly, neither reference discloses the limitation set forth in claim 26, namely an impingement area on the second member on which the fluid flow impinges to force the second member against the first member. Thus, applicants respectfully submit that this limitation present an additional basis for allowing claim 26.

In regard to claim 23, the Office Action indicates that the claim as recited is obvious based on Hojeibane in light of Thornton because the applicants have not disclosed how having the first opening with a greater open area than the second opening "solves any stated problem or is for any particular purpose." See Office Action of June 29, 2004 at page 3. Because of the sealing relationship claimed by the applicants, the interface between the members in the crotch region where the branching lumens join the main body may be of critical importance in some embodiments. In an embodiment in which the second opening has the same open area as the first opening (particularly if the first and second members are identical), the openings may overlap at the crotch region, potentially creating a poor seal where the openings come together, which may be aggravated if fluid flow forces the second member too far down into the first opening. In embodiments in which the second opening is smaller than the first opening, the entire periphery of the first opening, particularly the portion in the crotch region, may be able to contact graft material of the second member, creating a better seal. Also, the smaller opening in the second member may provide a greater fluid impingement area for driving the second member into the sealing relationship with the first member. The advantages of embodiments having the features recited in claim 23 are unique to the claimed invention of providing a sealing relationship in the trunk region of the interlocking members, further emphasizing the non-obviousness of the invention over the cited references.

To the extent that the Office Action raises the issue that the specification fails to state how the difference in the opening sizes solves any stated problem, the applicants respectfully submit that neither an applicant's arguments nor evidence traversing an obviousness rejection need be contained within the specification. The PTO may not disregard the evidence and arguments made by an applicant in response to an obviousness rejection on the grounds that the advantage is not disclosed in the application. *In re Chu*, 36 USPQ2d 1089, 1095 (Fed. Cir. 1995) (reversing PTO's rejection of improvement as "merely an obvious design choice"). To require evidence and argument that something is not merely a matter of design choice in the specification would be to require patent applicants "to divine the rejections the PTO will proffer when patent applications are filed." *Id.* at 1094. Accordingly, it is respectfully submitted that claim 23 is patentable over the prior art of record.

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BSI-481US

Summary

In view of the arguments set forth above, the applicants respectfully submit that claims 1-3 and 5-28, and 30-39 are in condition for allowance. Early and favorable notification to this effect is respectfully requested.

Respectfully submitted,



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